

PATENT APPLN. NO. 10/784,468
RESPONSE TO AND REQUEST FOR MODIFICATION
OF ELECTION REQUIREMENT

**PATENT
NON-FINAL**

In the Action, the applicant is required to elect one of the following claims, identified in the Action as "patentably distinct species of the claimed invention" (emphasis added):

- Species 1 - Claim 7;
- Species 2 - Claim 8;
- Species 3 - Claim 9;
- Species 4 - Claim 10;
- Species 5 - Claim 11;
- Species 6 - Claim 12;
- Species 7 - Claim 13;
- Species 8 - Claim 14; or
- Species 9 - Claim 15.

Claims 1-6 are identified in the Action as being generic.

The election of species requirement is improper because, first, the claims identified in the Action are not each species of the claimed INVENTION. The claimed invention is a wrapping packaging machine that comprises the following elements:

- (a) at least one track;
- (b) at least one film device;
- (c) at least one elongated body; and
- (d) at least one drive element.

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Claim 7 is directed only to a species of the elongated body, i.e., a chain adaptable to the shape of the track.

Claim 8 is directed only to a species of the drive element, i.e., a toothed wheel, and a species of the elongated body, i.e., an elongate body provided with a toothing corresponding to the teeth of the toothed wheel.

Neither claim 7 and 8 is a species of the claimed wrapping packaging machine itself since each is directed to only an element of the wrapping packaging machine.

Claim 9 is directed only to a species of the at least one track, i.e., a track that can be opened to allow the track to be placed so that it runs through a ring-shaped object to be packaged.

Claims 10-12 recite sub-species of the openable track of claim 9. These claims should properly depend on claim 9, directly or indirectly. There is no antecedent basis in claim 1 for the limitations of these claims. The dependency of these claims will be amended following the first action on the merits.

Claim 13 is also directed to a species of the at least one track, i.e., two tracks.

Claim 14 recites a sub-species of the track of claim 13 and should properly depend on claim 13. There is no antecedent basis

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in claim 1 for the limitations of claim 14. Claim 14 will be amended following the first action on the merits.

Claim 15 recites a separate embodiment of the invention which comprises a conveyor, two wrapping machines and two tracks.

Claims 9-15 are also directed only to elements of the wrapping packaging machine of the invention and are not distinct species of the claimed invention, i.e., the wrapping packaging machine.

The election of the claims requirement is also improper because claims are identified in the Action as the species of the claimed invention. However, as explained in MPEP 806.04(e), "claims are never species." Claims may be restricted to a single disclosed embodiment. Species are the specifically different embodiments (see MPEP 806.04(e)).

Moreover, since the identified claims do not define all of the species of the at least one track, at least one film device, at least one elongated body, or at least one drive element, requiring an election of one of the claims in light of the possibility that the application will be limited to the claim if no generic claim is found to be patentable deprives the applicant of the opportunity to obtain a patent directed to a desired species of the invention. For example, as noted above, claim 8 is directed to a species of the drive element, i.e., a toothed wheel. Claim 6 is also directed

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to a species of the drive element, i.e., a friction wheel, but is not included among the species to be elected. If required to elect a species of the drive element, applicant would prefer to elect the species of claim 6, but the Action does not provide him an opportunity to do so.

Applicant notes that a requirement for the applicant to elect a species of each of the elements (a)-(d) of the wrapping packaging machine of the invention as identified above would be a proper election of species requirement and would give the applicant an opportunity to make a proper election.

For each of these reasons, the election of species requirement is improper and should be removed and/or modified.

To ensure compliance with the election requirement, applicant elects, with traverse, claim 7 directed to a species of the elongated body, i.e., a chain adaptable to the shape of the track. Claims 1-6 and 9-15 are generic to the elongated track recited in claim 7.

A petition for a one-month extension of the period for responding to the Action of March 16, 2005, is being filed concurrently herewith. However, in the event that this paper is still not considered to be timely filed, applicant hereby petitions

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for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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